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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,113	10/25/2000	Louis Bouchard	LUCENT-01701	3907
28960	7590	04/15/2004	EXAMINER	
HAVERSTOCK & OWENS LLP 162 NORTH WOLFE ROAD SUNNYVALE, CA 94086			DENNISON, JERRY B	
			ART UNIT	PAPER NUMBER
			2143	8

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/697,113

**Applicant(s)**

BOUCHARD ET AL.

**Examiner**

J. Bret Dennison

**Art Unit**

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.  
2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-20 and 22-27 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,3-20 and 22-27 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This Action is in response to Amendment Paper #7 of Application Number 09/697,113 received on 01 April 2004.
2. Claims 1, 3-20, and 22-27 are presented for examination.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-20, and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cloutier et al. (U.S. Patent Number 6,535,586), hereinafter referred to by Cloutier, in view of Goldfinger et al. (U.S. Patent Number 6,449,344) hereinafter referred to by Goldfinger.

3. Regarding claims 1 and 20, Cloutier discloses a system and method of providing message notification for a user comprising the steps of:
  - coupling a message notification application to a server, wherein the server stores messages for the user (Cloutier, col. 3, lines 50-61);
  - registering the message notification application to at least one instant messaging service (Cloutier, col. 4, lines 15-25, Cloutier teaches a system for notification of

electronically stored messages that may be implemented using any type of devices capable of receiving a message);

Cloutier also discloses alerting the user of the receipt of new messages, working in conjunction with other messaging system architectures (Cloutier, col. 3, lines 33-41).

However, Cloutier does not disclose accessing one of the at least one instant messaging service by the user;

signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing; and

sending an instant message notification from the message notification application via the one instant message service to the user when a message arrives on the server for the user.

In an analogous art of the networking field, Goldfinger discloses a communication system using including accessing one of the at least one instant messaging service by the user (Goldfinger, col. 5, lines 35-50, Goldfinger teaches notifying that the user is connected to the system);

signing the user onto the message notification application by adding the user to a buddy list of the message notification application thereby associating the user to the one instant messaging service which the user is currently accessing (col. 6, lines 3-35, Goldfinger teaches a server containing a list of connected users which updates the lists of sought users predefined by users connected to the system); and

sending an instant message via the one instant message service to the user when a message arrives on the server for the user (col. 6, lines 35-50, Goldfinger teaches a server sending a message to a user when it arrives from another user).

Therefore, it would have been obvious to one in the ordinary skill in the art at the time of the invention to combine the system for notification and retrieval of electronically stored messages as disclosed by Cloutier, with the communication system using an instant messaging service as disclosed by Goldfinger to provide notification from the message notification application via an instant messaging service to the message recipient when a message arrives on the server for the user for the benefit of providing instant or direct notification to the user upon the receipt of a message (Cloutier, col. 1, lines 45-47).

4. Regarding claims 3 and 22, Cloutier and Goldfinger show all of the features of the invention, substantially as claimed, as described in claim 1 and 20, including retrieving the message by accessing the server (Goldfinger, col. 6, lines 40-45, Goldfinger teaches the server sending a message after checking if the user is still connected).

5. Regarding claims 4 and 23, Cloutier and Goldfinger show all of the features of the invention, substantially as claimed, as described in claim 3 and 22, including wherein the server is one of an application, a voice messaging and a unified messaging server (Goldfinger, col. 5, lines 30-35).

6. Regarding claims 5 and 24, Cloutier and Goldfinger show all of the features of the invention, substantially as claimed, as described in claim 3 and 22, including accessing the server by one of sending a request to the message notification application and using a telephone (Goldfinger, col. 5, lines 24-30).

7. Regarding claims 6 and 25, Cloutier and Goldfinger show all of the features of the invention, substantially as claimed, as described in claim 3 and 22, including retrieving messages from the server by an internet appliance (Goldfinger, col. 5, lines 25-30).

8. Regarding claims 7 and 26, Cloutier and Goldfinger show all of the features of the invention, substantially as claimed, as described in claim 3 and 22, including deleting a message using an internet appliance without retrieving the message from the server (col. 6, lines 50-65, Goldfinger teaches authorization for users to decide which users can send them messages).

9. Regarding claims 8 and 14, Cloutier discloses an apparatus and system for providing message notification and allowing a user to instantly review new messages comprising:

a message notification application registered to the at least one instant messaging service, wherein the message notification application includes a buddy list

onto which the user is added, thereby associating the user to one of the at least one instant message service that the user is currently using (Cloutier, col. 4, lines 15-25, Cloutier teaches a system for notification of electronically stored messages that may be implemented using any type of devices capable of receiving a message); and

a server for storing messages and providing a medium for the message notification application to operate (Cloutier, col. 3, lines 50-61).

Cloutier does not disclose an internet appliance to access the server and receive an instant message notification from the message notification application via the one instant messaging service, the instant message notification indicates that a new message is stored on the server for the user

In an analogous art in the networking field, Goldfinger discloses at least one instant messaging service (Goldfinger, col. 4, lines 49-60); and

an internet appliance to access the server and receive an instant message notification from the message notification application via the one instant messaging service, the instant message notification indicates that a new message is stored on the server for the user (col. 6, lines 50-65, Goldfinger teaches users on a computer terminal being able to receive messages). Goldfinger also teaches users having a list of sought users (col. 6, lines 3-15).

Therefore, it would have been obvious to one in the ordinary skill in the art at the time of the invention to combine the system for notification and retrieval of electronically stored messages as disclosed by Cloutier, with the communication system using an instant messaging service as disclosed by Goldfinger to provide notification from the

message notification application via an instant messaging service to the message recipient when a message arrives on the server for the user for the benefit of providing instant or direct notification to the user upon the receipt of a message (Cloutier, col. 1, lines 45-47).

10. Regarding claims 9 and 15, Cloutier and Goldfinger show all of the features of the invention, substantially as claimed, as described in claims 8 and 14, including further comprising means for automatically adding the user to the buddy list of the message notification application in response to the user signing up to receive messages with the message notification application (Goldfinger, col. 5, line 35 through col. 6, line 25, Goldfinger teaches a list of users updated when they sign on to the system).

11. Regarding claims 10 and 16, Cloutier and Goldfinger show all of the features of the invention, substantially as claimed, as described in claims 8 and 14, including wherein the message notification application comprises means for sending the user the instant message notification through the at least one instant messaging service when a message arrives for the user (Goldfinger, col. 6, lines 35-50).

12. Regarding claims 11 and 17, Cloutier and Goldfinger show all of the features of the invention, substantially as claimed, as described in claims 8 and 14, including retrieving the message from the server by one of sending a request to the message notification application and using a telephone (Goldfinger, col. 5, lines 24-30).



13. Regarding claims 12 and 18, Cloutier and Goldfinger show all of the features of the invention, substantially as claimed, as described in claims 8 and 14, including wherein the server is one of an application, a voice messaging and a unified messaging server (Goldfinger, col. 5, lines 30-35).

14. Regarding claims 13 and 19, Cloutier and Goldfinger show all of the features of the invention, substantially as claimed, as described in claims 8 and 14, including deleting the message using the Internet appliance without retrieving the message from the server (Goldfinger, col. 6, lines 50-65, Goldfinger teaches authorization for users to decide which users can send them messages).

15. Regarding claim 27, Cloutier discloses a method of providing a voice messaging notification application for a user in an instant messaging system comprising the steps of:

coupling a message notification application to a server, wherein the server stores messages for the user (Cloutier, col. 3, lines 50-61);

registering the message notification application to at least one instant messaging service (Cloutier, col. 4, lines 15-25, Cloutier teaches a system for notification of electronically stored messages that may be implemented using any type of devices capable of receiving a message);

However, Cloutier does not disclose accessing one of the at least one instant messaging services by the user;

adding the user to a buddy list of the message notification application, wherein the buddy list is associated with the one instant messaging service;

sending an instant message notification to the user from the message notification application via the one instant messaging service when a message arrives on the server for the user; and

allowing the user access to a server by one of using an internet appliance and using a telephone.

In an analogous art in the networking field, Goldfinger discloses adding the user to a buddy list of the message notification application, wherein the buddy list is associated with the one instant messaging service (Goldfinger, col. 6, lines 3-35, Goldfinger teaches a server containing a list of connected users which updates the lists of sought users predefined by users connected to the system);

sending an instant message notification to the user from the message notification application via the one instant messaging service when a message arrives on the server for the user (Goldfinger, col. 6, lines 35-50, Goldfinger teaches a server sending a message to a user when it arrives from another user); and

allowing the user access to a server by one of using an internet appliance and using a telephone(Goldfinger, col. 5, lines 24-30).

Goldfinger also teaches users having a list of sought users (col. 6, lines 3-15).

Therefore, it would have been obvious to one in the ordinary skill in the art at the time of the invention to combine the system for notification and retrieval of electronically stored messages as disclosed by Cloutier, with the communication system using an instant messaging service as disclosed by Goldfinger to provide notification from the message notification application via an instant messaging service to the message recipient when a message arrives on the server for the user for the benefit of providing instant or direct notification to the user upon the receipt of a message (Cloutier, col. 1, lines 45-47).

### ***Response to Arguments***

16. Applicant's argument include, the failure of the previously applied art to expressly disclose, "a server that receives a message intended for a user, and then stores the message for retrieval by the user, and sending an instant messaging notification from a message notification application to a user via an instant messaging service currently being accessed by the user." [see Applicant's response, Paper #7, pages 9 and 10], It is evident from the detailed mappings found in the above rejection that the prior art of record, clearly disclose this functionality. Further, it is clear from the numerous teachings (previously and currently cited) that the provision for receiving a message, storing the message at the server, and sending an instant message to the recipient through an instant messaging service is clearly taught. Thus, Applicant's arguments drawn toward distinction of the claimed invention and the prior art teachings on this point are not persuasive. It is also clear to the Examiner that the combination of

Cloutier and Goldfinger clearly teach the independent claims of Applicant's claimed invention.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (703) 305-8756. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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